

REMARKS

Applicants provide the present Amendment to address the issues raised in the Official Action mailed January 11, 2005. Applicants have cancelled Claim 17 to expedite prosecution of the present application.

The Objection to the Drawings

Figures 4 through 8 are objected to as being illegible. Official Action, p. 2. Applicants provide herewith replacement sheets containing Figures 4 through 8 redrawn to correct the legibility problems and with the Japanese language materials translated into English. Applicants submit that the replacement figures overcome the objection to the drawings.

The Objection to the Abstract

The Abstract is objected to as the term CM is not defined. Official Action, p. 3. Applicants have amended the abstract to clarify that CM refers to a commercial message. Accordingly, Applicants submit that the objection to the Abstract has been overcome.

The Section 112 Rejections

Claims 1, 2, 5, 13, 15 and 17 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Official Action, p. 4. In particular, the Official Action asserts that "the disclosure fails to state or teach one of ordinary skill in the art the best mode (by hand, computer or like device) for configuring the system or method to calculate the plurality of sales metrics (numbers, ratios, etc.) as claimed." Official p. 4.

Applicants submit that the disclosure clearly describes the computer implemented system that is claimed in Claims 1, 2 and 5. Applicants have also amended Claim 1 to clearly recite that the system is a computer implemented system and the recitations of Claims 1, 2 and 5 are computer implemented. Applicants submit that such amendments are clearly supported by the specification. For example, Claim 1 recites a district sales forecasting section and a shop sales forecasting section. These sections are clearly described as sections 6 and 7 of the server 3 (computer) illustrated in Figure 1 and described, for example, beginning at page 9, line 5 of the

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In the Drawings

Please replace Figures 4 through 8 with the drawings on Replacement Sheets 4 through 8. The Replacement Sheets have translated the Japanese in Figures 4 through 8 to English and have made the drawings more legible.

present specification. The district ratio calculating portion and the district sales number calculating portion recited in Claim 2 are described with reference to the TV area sales number forecasting section 6 of Figure 1, for example, with reference to the sales number area ratio pattern creating portion 17 and the area commodity sales number calculating portion 23. The district purchasing trend forecasting section, the shop purchasing trend forecasting section and the shop commodity sales number calculating section of Claim 5 are described with reference to items 26 through 28 of Figure 1. The operations for operating the commodity sales number forecasting system 1 of Figure 1 are described the flowcharts of Figures 2 and 3, which are described as "the procedures of processing in a computer program." As such, Applicants submit that Claims 1, 2 and 5 are clearly enabled by the present disclosure.

Claim 13 and 15 are directed to a computer program product that executes on a computer. Claim 17 has been cancelled. As such, Applicants are unclear as to what the disclosure fails to teach with regard to these claims. Clearly these claims are intended to cover computers programmed to or computer programs that calculate the recited metrics. As such, these claims are not directed to performing these calculations by hand but, instead, are directed to programming of the computer as described above with reference to Claims 1, 2 and 5. Accordingly, Applicants submit that these claims are enabled and request withdrawal of the rejection.

Claims 1-17 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Official Action, p. 5. In particular, the Official Action asserts that the claims "are generally narrative and indefinite, failing to conform with current U.S. practice." Official Action, p. 5. The Official Action further asserts that the claims are "replete with grammatical and idiomatic errors." Official Action, p. 5. No particular language of the claims is cited with regard to any of the claims except Claims 1 and 5. Accordingly, Applicants are unsure as to how the claims are indefinite. Applicants submit that the claims conform to current U.S. practice in that each of the claims recites specific structures, operations or program instructions. Accordingly, Applicants submit that Claims 1-17 are not indefinite.

With regard to Claims 1 and 5, the Official Action asserts that the disclosure does not clearly define the phrase system and that "without further definition of the system elements the

phrase as claimed is vague and indefinite." Official Action, p. 5. Applicants submit that these claims specifically recite the structure that is part of the system. Accordingly, what is included in the system is not indefinite and the claims themselves provide the further definition of the elements of the system. Accordingly, Applicants submit that Claims 1 and 5 are not indefinite.

The Section 101 Rejection

Claims 1-17 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Official Action, p. 6. In particular, the Official Action asserts that the claims are not within the technological arts and are mere abstract ideas. Official Action, p. 6.

Applicants note that Claims 13-17 are not discussed in the rejection. Applicants submit that these claims are directed to statutory subject matter as they are directed to computer program products or a storage medium containing a computer program. Such subject matter is clearly within the technological arts.

With regard to Claims 1-12, while Applicants do not concur in the propriety of the rejection of these claims, to advance prosecution of the present application, Applicants have amended the independent claims to recite either a computer implemented system (Claims 1 and 5) or a computer implemented method (Claim 9). As such, Applicants submit that these claims clearly recite specific systems or methods that are not abstract ideas that could be performed in the mind of a user or by the use of a pencil. As such, Applicants submit that Claims 1-12 are directed to statutory subject matter.

The Section 103 Rejection

Claims 1-17 stand rejected as obvious under 35 U.S.C. § 103 in light of United States Publication No. 2002/0169657 to Singh et al. (hereinafter "Singh"). Official Action, p. 9. As discussed above, Claim 17 has been cancelled.

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. See M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). As discussed in further detail below, Applicants submit that the Official Action has failed to establish a prima facie case of obviousness as the cited reference does not disclose or suggest each of the recitations of the claims and a proper motivation to combine the references in the manner cited in the claims has not been established.

Initially, Applicants note that the Official Action relies on "Official Notice" as to certain teachings in the art. See e.g., Official Action, pp. 12, 13, 15, 16-18. Applicants request that the Examiner support such assertions with citations to a reference or references as the Official Notice taken in the Official Action appears to be so vague that Applicants cannot properly

address the combination of the "Official Notice" with the single cited Singh reference. *See* § M.P.E.P. 2144.03.

With regard to independent Claim 1, Applicants note that Claim 1 recites a specific configuration of computer implemented system according to some embodiments of the present invention. For example, Claim 1 recites, in part:

a computer implemented **district sales number forecasting section** configured to **calculate the forecast sales number** of a commodity within said predetermined district **for each unit advertising district** residing within said predetermined district **performing sales promotion activity at the same time by use of a predetermined advertising medium;** and

a computer implemented **shop sales number forecasting section** configured to **calculate the forecast sales number at each shop by distributing the forecast sales number of said commodity in said unit advertising district to each shop within said unit advertising district.**

Claim 1, emphasis added. The highlighted recitations of Claim 1 are never specifically discussed in the rejection. While the rejection of Claim 1 generally discussed forecasting, the Official Action never cites to any portion of Singh or take Official Notice as teaching these specific recitations of Claim 1. For example, merely because sales forecasting is known or even that advertising affects sales forecasts does not suggest a district sales number forecasting section that calculates forecast sales numbers for each advertising district that is performing the same sales promotion activity at the same time or a shop sales number forecasting section that distributes the forecast sales numbers in a unit advertising district to each shop in the district.

Applicants submit that an obviousness rejection may not be properly established without finding each of the recitations of Claim 1 in the prior art or a suggestion to modify the prior art to result in the recitations of Claim 1. As discussed above, the Official Action does not even mention many of the recitations of Claim 1. Based on the portions of Singh cited in the Official Action, the Singh reference appears to be a system for comparing various demand forecasting models. *See* Singh, Abstract. The cited portions of Singh do not appear to describe the specific system recited in Claim 1. Furthermore, the Official Action fails to provide a convincing line of reasoning as to why Singh would be modified to result in, for example, the highlighted portions of Claim 1 and, in fact, never discusses the specific recitations of Claim 1. It appears that the

Official Action is asserting that all forecasting systems are obvious because Singh teaches that various history data may be used in demand forecasting and that various business metrics are known. The Official Action, however, never cites to any reference or even takes Official Notice that the specific calculations with the specific district, advertising unit and shop specifications recited in Claim 1 are known. To the extent that the Official Action is taking Official Notice that the specific determinations recited in Claim 1 are well known in the art, Applicants request that the Examiner support such an assertion by citation to a reference. The fact that someone could do the things asserted on page 12 of the Official Action is irrelevant to the issue of obviousness. What is relevant is whether someone has done the things recited in the claims or the recitations are obvious from what some has done, not speculation as to what someone could have done. Applicants, therefore, submit that the rejection of Claim 1 is based on unspecified references and unsupported conclusory allegations of motivation to modify the Singh reference to result in the recitations of Claim 1. Accordingly, Applicants submit that a prima facie case of obviousness has not been established with respect to Claim 1.

Claim 5 is an independent system claim that recites, in part:

a computer implemented **district purchasing trend forecasting section** configured to **calculate a forecast index representing a customers' purchasing trend for each commodity in each unit advertising district performing sales promotion activity at the same time** by means of a predetermined advertising medium;

a computer implemented **shop purchasing trend forecasting section** configured to **calculate a forecast ratio of said forecast index at a predetermined shop** within said unit advertising district to said forecast index in said unit advertising district; and

a computer implemented **shop commodity sales number calculating section** configured to **calculate the forecast sales number of said commodity at said predetermined shop on the basis of the said forecast index, said forecast ratio and a forecast number of visitors coming to said predetermined shop.**

Claim 5, emphasis added. Claim 9 is an independent method claim that recites, in part:

calculating a **forecast total commodity sales number within said predetermined district;**

calculating a **forecast ratio of a forecast commodity sales number per unit visitor number in said unit district to a forecast commodity sales number per unit visitor number in said predetermined district;** and

calculating a **forecast total commodity sales number within said unit district using said forecast total commodity sales number and said forecast ratio.**

Claim 9, emphasis added.

As with Claim 1, the Official Action appears to assert that all techniques for forecasting sales are known and, therefore, the specific techniques recited in Claims 5 and 9 are obvious in light of Singh's use of models to forecast demand. Applicants submit that the rejection of these claims is based on the use of hindsight in light of the present disclosure. As acknowledged in the Official Action, Singh does not disclose the specific recitations of the claims on how sales of the commodity are forecast. *See e.g.*, Official Action, p. 13. The Official Action then relies on Official Notice as teaching the recitations of Claims 5 and 9. As such, Applicants request that the Examiner support the assertions that the recitations of Claims 5 and 9 for calculating commodity sales are known in the art by providing a reference supporting the assertion. Applicants submit that a proper obviousness rejection has not been established when, for example, with respect to Claim 9, essentially all of the recitations of the claims except the preamble are rejected based on "Official Notice." Accordingly, Applicants submit that the Official Action fails to establish a prima facie case of obviousness with respect to independent Claims 5 and 9.

With regard to independent Claim 12, Applicants submit that a prima facie case of obviousness has not been established for these claims for reasons analogous to those discussed above with reference to Claims 1, 5 and 9. In particular, Applicants submit that merely because it is known to calculate sales forecasts based on various business metrics does not establish that it was known to use the specific recitations of Claim 12 and that the Official Action appears to be speculating as to what could be done, rather than what has been done or has been suggested. Accordingly, Applicants request that the Examiner support the rejection of Claim 12 with citations to references or withdraw the rejections.

As discussed above, Applicants submit that a prima facie case of obviousness has not been established with respect to the independent Claims 1, 5, 9 and 12. As such, Applicants submit that a prima facie case of obviousness also has not been established with respect to the claims that depend from these claims.

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Conclusion

In light of the above discussion, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. J. O'Sullivan", with a long horizontal flourish extending to the right.

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